

**REMARKS**

A telephone interview was held on May 28, 2003 and attended by Examiner Zohreh Fay and Applicants' attorney Janet M. MacLeod. No exhibits were shown nor demonstrations conducted. Claims 1-3 were discussed. U.S. Patent No. 6,124,353 to Woodward ("Woodward") was discussed.

With respect to the rejection of Claims 1-3 under 35 U.S.C. § 112, first paragraph, Applicants' attorney argued that the specification provides an enabling disclosure for the subject matter of the claims. With respect to the rejection of Claims 1-3 under 35 U.S.C. § 103(a), Applicants attorney argued that there would not have been motivation to substitute a cyclic aliphatic hydrocarbon or aromatic hydrocarbon or combination of aliphatic and aromatic hydrocarbon for the naturally occurring straight chain hydrocarbon substituent of the prior art. No agreement was reached. Applicants thank the Examiner for the helpful comments she conveyed during the interview.

In the Office Action mailed April 4, 2003, the reissue declaration has been alleged to be defective for failing to contain a statement of error. Submitted herewith is a Reissue Application Declaration by the Assignee which identifies at least one error which is relied upon to support the reissue application.

Claims 1-3 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter not enabled by the specification. The Examiner has alleged that support and examples for the phrase "cyclic aliphatic aromatic" groups is not provided, and that the skilled artisan could not ascertain physiological activity of these compounds without undue experimentation.

Applicants respectfully submit that the claimed methods of using compounds in which "substituent Z is a hydrocarbon group selected from the group of cyclic aliphatic, aromatic, or a combination of aliphatic and aromatic hydrocarbon" are supported by an enabling disclosure in the specification, and that the skilled artisan can make and use such compounds in the absence of undue experimentation.

The specification discloses, for example, at Column 2, lines 31-49, compounds of Formula I in which the Z substituent at carbon 16 may be a cyclic aliphatic hydrocarbon, an aromatic hydrocarbon, or a combination thereof. The terms "cyclic aliphatic" and "aromatic" are

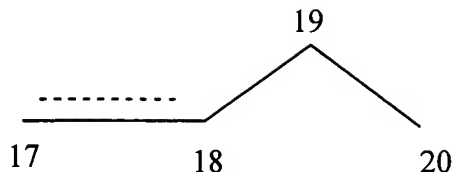
well-known to and understood by those of ordinary skill in the art, and thus the present disclosure is sufficient to satisfy the requirements of 35 U.S.C. § 112, first paragraph. It is well-established that a patent need not teach, and preferably omits, that which is well-known in the art. In re Wands, 858 F.2d 731, 735, 8 U.S.P.Q.2d 1400, 1402 (Fed. Cir. 1988); , 858 F.2d 731, 735, 8 U.S.P.Q.2d 1400, 1402 (Fed. Cir. 1988); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 U.S.P.Q. 81, 95 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

The specification further sets forth, at Col. 3, lines 57-60, an example of a Z substituent that is a combination of an aliphatic and aromatic hydrocarbon, i.e., a methyl phenyl group. New Claim 22, directed to a method utilizing a compound of the invention in which Z is a methyl phenyl group, has been added. In addition, the specification teaches one of skill in the art to identify compounds having the ability to decrease intraocular pressure, for example at Col. 4, line 52 – Col. 5, line 12. While some experimentation may be necessary, it is not undue, and thus the claims meet the enablement requirements of 35 U.S.C. § 112, first paragraph. Accordingly, withdrawal of the rejection of Claims 1-3 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Claims 1-3 have been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 6,124,353 to Woodward. The Examiner has alleged that Woodward teaches the use of prostaglandins for the treatment of ocular hypertension, and that it would have been obvious to substitute a cyclic aliphatic group, an aromatic group, or a combination of an aliphatic and aromatic hydrocarbon of the compounds of the present invention for the aliphatic group of the compounds of Woodward at the Z position.

Applicants respectfully submit that the subject matter of the claims is not obvious in view of Woodward, because one of ordinary skill in the art would not have been motivated to substitute the Z substituent of the present invention for the aliphatic hydrocarbon substituent of the compounds of Woodward.

In each of the prostaglandin compounds disclosed by Woodward, the group that corresponds to the Z substituent of the compounds of the present invention is an aliphatic hydrocarbon having four carbons. This straight chain hydrocarbon is represented by Woodward as follows, wherein the dotted line between C-17 and C-18 indicates a single or double bond:



This substituent in the prostaglandin compounds of Woodward is the same as the C-17 to C-20 chain in the naturally occurring prostaglandins.

In contrast, in the compounds of the present invention, the straight-chain C-17 to C-20 group is replaced by a hydrocarbon group selected from the group of cyclic aliphatic, aromatic, or a combination of aliphatic and aromatic hydrocarbon, i.e., the Z substituent. The Z substituent in the compounds of the present invention is not contained in naturally occurring prostaglandins.

There is neither implicit nor explicit suggestion in Woodward to substitute the present Z substituent for the naturally occurring prostaglandin component present in Woodward's compounds. Further, the present rejection under 35 U.S.C. § 103(a) is silent as to the source of the motivation for one of ordinary skill in the art to make such a substitution.

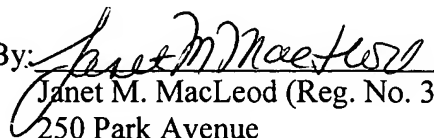
To establish obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination. In re Kotzab, 208 F.3d 1365, 1370, 54 U.S.P.Q.2d 1308, 1316 (Fed. Cir. 2000). Accordingly, a prima facie case of obviousness has not been established. Withdrawal of the rejection of Claims 1-3 under 35 U.S.C. § 103(a) is respectfully requested.

In view of the foregoing remarks and amendments, it is respectfully submitted that the present application is in condition for allowance. Favorable consideration of all pending claims is earnestly solicited.

Respectfully submitted,

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